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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/475,950

12/31/1999

FRANK S. SAAVEDRA-LIM

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919 7590 07/05/2007

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EXAMINER

O'CONNOR, GERALD J

ART UNIT

PAPER NUMBER

3627

MAIL DATE

DELIVERY MODE

07/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/475,950

Applicant(s)

Saavedra-Lim

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on February 16, 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9, and 10 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9, and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on July 31, 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution Reopened

1. In view of the appeal brief filed on February 16, 2007, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.
2. To avoid abandonment of the application, appellant must exercise one of the following two options:
 - (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
 - (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

Information Disclosure Statement

3. The information disclosure statement filed February 3, 2003 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. Therefore, the references have been placed in the application file, but unless the examiner has cited the references on form PTO-892, they have not been considered.

Drawings

4. Corrected or substitute drawings were received on July 31, 2003. These drawings have been approved.

Claim Rejections - 35 USC § 112, Second Paragraph

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1-6, 9, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Where applicant acts as his or her own lexicographer to specifically define an otherwise undefined term of a claim, the written description must clearly define the exact claim term and explicitly set forth the precise definition so as to put one reasonably skilled in the art on notice that applicant intended to so define that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). In this case, the term “fraudi” in claim 1 (lines 20 and 21) is used by the claim apparently to mean “fraud indicator,” but there is no accepted meaning for the term. The term is indefinite because the specification does not clearly define the term by explicitly setting forth any precise definition.

Applicant can overcome this rejection by amending each of the four recitations of the term “fraudi” in lines 20 and 21 of claim 1 to instead recite --fraud indicator--.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-6, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebda et al. (US 6,385,594), in view of Keen et al. (US 5,774,882).

Lebda et al. disclose a method of managing and assessing a set of risks relative to a financial product, said method being accessed through a data processing system, wherein said data processing system comprises a series of nodes operatively connected with each other, said method comprising the steps of: (a) performing an application processing procedure on one or more customers, comprising a check of the creditworthiness of one or more selected customers; and issuing a financial product to one or more of said customers if said selected customer is determined to be creditworthy, thus resulting in an accepted customer, and declining said application if said customer is determined to be not creditworthy; (b) assessing a credit authorization request from a system user, wherein said request is initiated by a use of said financial product; (c) utilizing a predictive modeling routine to perform said assessment; (d) accepting or declining said credit authorization request as based upon an outcome of said assessment; (e) downloading an assessment result to said data processing system for transfer to a

database accessible by one or more remote nodes of said system, but Lebda et al. do not disclose (f) applying a fraudi to each assessment and wherein said fraudi is selected from a list of fraudi and wherein each of said fraudi on the list is representative of a defined area of risk.

However, Keen et al. disclose a similar method, and the method of Keen et al. indeed includes applying a fraudi to each assessment and wherein said fraudi is selected from a list of fraudi and wherein each of said fraudi on the list is representative of a defined area of risk.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Lebda et al. so as to include the step of applying a fraudi to each assessment and wherein said fraudi is selected from a list of fraudi and wherein each of said fraudi on the list is representative of a defined area of risk, in accordance with the teachings of Keen et al., in order to help identify/predict which applications were likely to be fraudulent.

Regarding claim 2, in the method of Lebda et al., the financial product is a credit card.

Regarding claims 3-6, the recitations drawn to the nature of the particular entity applying for the credit, whether it be a business entity or an individual entity, have been deemed merely directed to an intended usage of the device, hence, afforded little patentable weight. See MPEP §§ 2114 and 2173.05(g). Additionally, however, note that Keen et al. do indeed disclose using their method to serve both individual entities and business/corporate entities.

Regarding claim 9, in the method of Lebda et al., a set of data relative to said credit authorization request is retained in a memory of said data processing system, Lebda et al. do not explicitly disclose that the data is retained for the purpose of being utilized to determine the

effectiveness of an assessment methodology. However, reviewing results to determine the effectiveness of a method over time is certainly well known, hence obvious, to those of ordinary skill in the art of lending, and official notice to that effect is hereby taken. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the method of Lebda et al. so as to utilize the retained results for the purpose determining the effectiveness of an assessment methodology (if such was not already being done), as is well known to do, in order to learn how to continually improve the assessment methodology to identify a greater and greater percentage of the fraudulent applications, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claim 10, in the method of Lebda et al., a filtering step comprises a credit score filter for eliminating a portion of a population that does not pass through said filter.

Response to Arguments

9. Applicant's arguments filed February 16, 2007 have been fully considered but they are not deemed persuasive.

10. The arguments regarding the previous prior art rejections have been considered, but have been rendered moot by the new grounds of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to the disclosure.
12. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

Official replies to this Office action may now be submitted electronically by registered users of the EFS-Web system. Information on EFS-Web tools is available on the Internet at: <http://www.uspto.gov/ebc/portal/tools.htm>. An EFS-Web Quick-Start Guide is available at: <http://www.uspto.gov/ebc/portal/efs/quick-start.pdf>.

Alternatively, official replies to this Office action may still be submitted by any **one** of fax, mail, or hand delivery. **Faxed replies should be directed to the central fax at (571) 273-8300.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

June 18, 2007

 6/18/07

Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627